



12 JUL 2006

Mitchell W. Shapiro
Miles & Stockbridge, P.C.
1751 Pinnacle Drive, Suite 500
McLean, VA 22102-3833

In re Application of	:	
ALI, et al.	:	DECISION ON PETITION
Serial No.: 10/527,167	:	
PCT No.: PCT/GB03/03903	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 09 September 2003	:	
Priority Date: 10 September 2002	:	
Atty Docket No.: XA-10290	:	
For: CLAMPING APPARATUS FOR ADJUSTABLE	:	
STEERING COLUMN FOR A VEHICLE	:	

This decision is in response to applicant's "PETITION UNDER 37 C.F.R. § 1.47" filed 06 March 2006 in the United States Patent and Trademark Office (USPTO) to accept the application without the signature of co-inventor Mohammed Ali.

BACKGROUND

On 09 September 2003, applicant filed international application PCT/GB03/03903, which claimed priority of an earlier application filed 10 September 2002. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 25 March 2004. Pursuant to 37 CFR 1.495, the thirty-month period for paying the basic national fee in the United States expired at midnight on 10 March 2005.

On 09 March 2005, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a preliminary amendment, and an Information Disclosure Statement.

On 28 July 2005, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. Applicant was afforded two months to file the proper reply and informed that this period could be extended pursuant to 37 CFR 1.136(a).

On 28 December 2005, applicant filed a declaration executed by co-inventor Moriyama accompanied by authorization to charge any necessary extension of time payments.

On 06 February 2006, applicant was mailed a "NOTIFICATION OF DEFECTIVE RESPONSE" (Form PCT/DO/EO/916) informing applicant that the filed declaration did not comply 37 CFR 1.497 (a) and (b) and thus was not a proper response to the Form PCT/DO/EO/905 mailed 28 December 2005. Applicant was afforded one month from the mailing of the Form PCT/DO/EO/916 or within the time remaining in the response set forth in the Form PCT/DO/EO/905, whichever was longer.

On 06 March 2006, applicant filed the present petition under 37 CFR 1.47(a) to accept the application without the signature of co-inventor Mohammed Ali.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1, 3 and 4.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." 409.03(d) also states that:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts.

In the present case, applicant has provided a declaration from Mr. Laurence Barton detailing his attempts to obtain the signature of inventor Ali. Mr. Barton states that the inventor ultimately refused to accept the papers and stated that he would not sign the declaration. However, applicant has not included any of the noted text messages sent from Mr. Barton nor other evidence that would show that Mr. Ali knew specifically which invention was being discussed when he refused to accept the papers or sign the declaration. In a situation such as this where applicant is seeking to proceed on the basis of an oral refusal combined with non-receipt of a complete set of the application papers, applicant must provide a showing that the inventor

was aware of the particulars of what he was being asked to sign.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Derek A. Putonen
Attorney Advisor
Office of PCT Legal Administration
Tel: 571-272-3294
Fax: 571-273-0459